

1

REMARKS

2 Claims 2-11 and 13-16 have been cancelled without
3 prejudice or disclaimer and claims 1, 12, and 17 have been
4 amended.

5 Applicant respectfully requests further examination and
6 reconsideration of claims 1, 12, 17, and 18, now pending in
7 the application.

8 The Office Action mailed from the Patent Office on
9 October 21, 2004 has been carefully considered and indicates
10 that:

11 a) Claims 1-10 are
12 rejected under 35
13 U.S.C. 102(e) as
14 being anticipated by
15 Ang;

16 b) Claims 1-4 are
17 rejected under 35
18 U.S.C. 102(b) as
19 being anticipated by
20 Hamrah; and

21 c) Claims 1-18 are
22 rejected under 35
23 U.S.C. 103(a) as
24 being unpatentable
25 over Ang in view of
26 Higgins et al.

27 In response to the Examiner's rejection of claims 1-10
28 under 35 U.S.C. 102(e) as being anticipated by Ang, the
29 Examiner's rejection of claims 1-4 under 35 U.S.C. 102(b) as
30 being anticipated by Hamrah, and the Examiner's rejection of

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1 claims 1-18 under 35 U.S.C. 103(a) as being unpatentable over
2 Ang in view of Higgins et al., applicant has:

- 3 1. Cancelled claims 2-11 and 13-16 without prejudice or
4 disclaimer.
- 5 2. Amended claim 1 to include the limitations of cancelled
6 claims 5, 10, 11, and 13-16.
- 7 3. Amended claims 12 and 17 to reflect proper dependency.

8 Applicant respectfully draws the Examiner's attention to
9 the fact that the Federal Circuit holds that relevant case law
10 must be relied upon in determining obviousness; the
11 determination of obviousness is a matter of law, as was
12 decided in In re Deuel, 51 F.3d 1552, 1557, 34 USPQ.2d (BNA)
13 1210, 1214 (Fed. Cir. 1995), where the Court held:

14 "Obviousness is a
15 question of law,
16 which we review de
17 novo, though factual
18 findings underlying
19 the Board's
20 obviousness
21 determination are
22 reviewed for clear
23 error. In re
24 Vaack, 947 F.2d 488,
25 493, 20 USPQ2d 1438,
26 1442 (Fed. Cir.
27 1991); In re
28 Woodruff, 919 F.2d
29 1575, 1577, 16
30 USPQ2d 1934, 1935
31 (Fed. Cir.
32 1990)." [at 1214]
33 [Emphasis added]

34 And, in Richardson-Vicks Inc. v. The Upjohn Co., 122 F.3d
35 1476, 44 USPQ.2d 1181 (Fed. Cir. 1997), where the Court held:

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1 "The difficulty with
2 RVI's position is
3 that, although the
4 argument has merit
5 when the issue is
6 purely one of fact,
7 it does not follow
8 when the issue
9 involves a question
10 of law. It is black
11 letter law that the
12 ultimate question of
13 obviousness is a
14 question of law." See
15 Graham v. Deere Co.,
16 383 U.S. 1, 17, 148
17 USPQ 459, 467 (1966)
18 (citing Great A. &
19 P. Tea Co. v.
20 Supermarket Equip.
21 Co., 340 U.S. 147,
22 155, 87 USPQ 303,
23 309 (1950)); In re
24 Donaldson Co., 16
25 F.3d 1189, 1192, 29
26 USPQ2d 1845, 1848
27 (Fed. Cir. 1994) (in
28 banc); Texas
29 Instruments Inc. v.
30 Unit States Int'l
31 Trade Comm'n, 988
32 F.2d 1165, 1178, 26
33 USPQ2d 1018, 1028
34 (Fed. Cir. 1993).
35 And we review that
36 legal question
37 without deference to
38 the trial court.
39 See Gardner v. TEC
40 Sys. Inc., 725 F.2d
41 1338, 1344, 220 USPQ
42 777, 782 (Fed. Cir.
43 1984) (district
44 court's conclusion
45 on obviousness "is
46 one of law and

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1 subject to full and
2 independent review
3 in this court"). "[at
4 1183] [Emphasis
5 added]

6 In the seminal case of Graham v. John Deere Co., 383 U.S.
7 1, 17, 148 USPQ 459, 467, 15 L.Ed. 2d 545, 86 S. Ct. 684
8 (1966), the Supreme Court articulated the requirements for a
9 prima facie holding of obviousness. The Patent Office has
10 since set forth in MPEP 706.02 a three step requirement for
11 establishing a prima facie case of obviousness.

12 The first step requires that the Examiner must set forth
13 the differences in the claim over the applied references. The
14 second step requires that the Examiner must set forth the
15 proposed modification of the reference which would be
16 necessary to arrive at the claimed subject matter. And, the
17 third step requires that the Examiner must explain why the
18 proposed modification would be obvious.

19 The Courts have currently required that in order to
20 satisfy the third step for establishing a prima facie case of
21 obviousness, the Examiner must identify where the prior art
22 provides a motivating suggestion to make the modifications
23 proposed in the second step for establishing a prima facie
24 case of obviousness, as was expressed in the 1992 Federal
25 Circuit Court decision in In re Jones, 958, F.2d 347, 21
26 USPQ.2d 1941, where the Court held:

27 "Contention that one
28 skilled in the
29 herbicidal art would
30 have been motivated
31 to use, with acid
32 commonly known as

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1 " d i c a m b a , "
2 substituted ammonium
3 salt such as that
4 disclosed in two
5 prior references
6 does not warrant
7 holding that claimed
8 substituted ammonium
9 salt of dicamba for
10 use as herbicide is
11 prima facie obvious,
12 since there is no
13 suggestion for
14 c o m b i n i n g
15 disclosures of those
16 references either in
17 r e f e r e n c e s
18 themselves, which
19 are directed to
20 shampoo additives
21 and production of
22 m o r p h o l i n e ,
23 respectively, or in
24 knowledge generally
25 available to those
26 skilled in the art."
27 [at 1941] [Emphasis
28 added]

29 "The Solicitor
30 points out that,
31 given the breadth of
32 forms of dicamba
33 (free acid, ester,
34 or salt) disclosed
35 by Richter as having
36 herbicidal utility,
37 one of ordinary
38 skill in the art
39 would appreciate
40 that the dicamba
41 g r o u p h a s
42 significance with
43 respect to imparting
44 herbicidal activity
45 t o d i c a m b a

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1 compounds. Thus,
2 the solicitor
3 contends, one
4 skilled in the art
5 would have been
6 motivated to uses,
7 with dicamba,
8 substituted ammonium
9 salts made from a
10 known amine, such as
11 the amine disclosed
12 by Zorayan and
13 Wideman, and would
14 have expected such a
15 salt to have
16 herbicidal activity.
17 Before the PTO may
18 combine the
19 disclosures of two
20 or more prior art
21 references in order
22 to establish prima
23 facie obviousness,
24 there must be some
25 suggestion for doing
26 so, found either in
27 the references
28 themselves or in the
29 knowledge generally
30 available to one of
31 ordinary skill in
32 the art." In re
33 Fine, 837 F.2d 1071,
34 1074, 5 USPQ2d 1596,
35 1598-99 (Fed. Cir.
36 1988). We see no
37 such suggestion in
38 Zorayan, which is
39 directed to shampoo
40 additives, nor
41 Wideman, which
42 teaches that the
43 amine used to make
44 the claimed compound
45 is a byproduct of
46 the production of

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1 morpholine. Nor
2 does the broad
3 disclosure of
4 Richter fill the
5 gap, for the reasons
6 discussed above." [at
7 1943-44] [Emphasis
8 added]

9 And, in Arkie Lures, Inc. v. Gene Larew Tackle, Inc., 912
10 F.Supp. 422, 38 USPQ.2d 1300 (W.D.Ark. 1996), where the Court
11 held:

12 "The existence of
13 separate elements of
14 the invention in the
15 prior art is
16 insufficient to
17 e s t a b l i s h
18 obviousness, absent
19 some teaching or
20 suggestion in the
21 prior art to combine
22 the elements."
23 [Emphasis added]

24 And, in Gambro Lundia AB v. Baxter Healthcare
25 Corporation, 110 F.3d 1573, 42 USPQ.2d 1378 (Fed. Cir. 1997),
26 where the court held:

27 " Without a
28 suggestion or
29 teaching to combine,
30 a case of
31 obviousness is
32 d e f i c i e n t . "
33 [Emphasis added]

34 The Courts further require, however, that even if the
35 prior art may be modified, as suggested by the Examiner, does
36 not make the modification obvious unless the prior art

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1 suggests the desirability of the modification, as was
 2 expressed in the 1992 Federal Circuit Court decision in In re
 3 Fritch, 922, F.2d 1260, 23 USPQ.2d 1780, where the Court held:

4 "Mere fact that
 5 prior art may be
 6 modified to reflect
 7 features of claimed
 8 invention does not
 9 make modification,
 10 and hence claimed
 11 invention, obvious
 12 unless desirability
 13 of such modification
 14 is suggested by
 15 prior art...."[at
 16 1780] [Emphasis
 17 added]

18 "The mere fact that
 19 the prior art may be
 20 modified in the
 21 manner suggested by
 22 the Examiner does
 23 not make the
 24 modification obvious
 25 unless the prior art
 26 suggested the
 27 desirability of the
 28 modification. In re
 29 Gordon, 733 F.2d at
 30 902, 221 USPQ at
 31 1127."[at 1783]
 32 [Emphasis added]

33 In this same regard, the Examiner's attention is
 34 respectfully drawn to the decisions in Heidelberger
 35 Druckmaschinen AG v. Hantscho Commercial Products, Inc., 21
 36 F.3d 1068, 30 USPQ.2d 1377; In re Fine, 837 F.2d 1071, 5
 37 USPQ.2d 1596 (Fed. Cir. 1988); In re Keller, 642 F.2d 413, 208

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1 USPQ 871 (CCPA 1981); and In re Merck & Co., Inc., 800 F.2d
2 1091, 231 USPQ 375 (Fed. Cir. 1986).

3 In properly applying the Graham v. John Deere Co. test
4 in light of, inter alia, In re Jones and In re Fritch,
5 discussed supra, the Examiner must conduct a rigorous
6 examination and analysis of the prior art. It would appear
7 that the Examiner has not done so.

8 Neither Ang, Hamrah, nor Higgins et al. make any
9 motivating suggestion that, inter alia, the edge binding of
10 Ang can be modified to use the welt with an anchoring tape of
11 Higgins et al., as suggested by the Examiner, let alone the
12 desirability of such a modification.

13 The Examiner has merely combined elements in a piecemeal
14 manner in light of applicant's disclosure to show obviousness
15 by using applicant's own specification as though it were prior
16 art and in doing so has violated the basic mandate inherent
17 in 35 U.S.C. 103, as was decided in In re Kamm and Young, 172
18 USPQ 298, where the Court held:

19 "Basic mandate
20 inherent in 35
21 U.S.C. 103 is that
22 piecemeal
23 reconstruction of
24 prior art patents in
25 light of applicants'
26 disclosure shall not
27 be basis for holding
28 of obviousness."[at
29 298][Emphasis added]

30 "The rejection here
31 runs afoul of a
32 basic mandate
33 inherent in section
34 103 - that a

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1 ' p i e c e m e a l
2 reconstruction of
3 the prior art
4 patents in the light
5 of appellants'
6 disclosure' shall
7 not be the basis for
8 a holding of
9 obviousness. In re
10 Rothermel, 47 CCPA
11 866, 870, 276 F.2d
12 393, 396, 125 USPQ
13 328, 331, (1960)"[at
14 301][Emphasis added]

15 And, in In re Stephens, Wenzl, and Browne, 145 USPQ 656
16 (CCPA 1965), where the Court reversed a rejection on a
17 combination of references and held:

18 "References may not
19 be combined
20 indiscriminately and
21 with guidance from
22 a p p l i c a n t ' s
23 disclosure to show
24 that the claims are
25 unpatentable."[at
26 656][Emphasis added]

27 " I n o u r
28 consideration of the
29 record in light of
30 a p p e l l a n t s '
31 arguments, we find
32 nothing which
33 demonstrates that
34 the examiner and the
35 board erred in
36 rejecting the
37 claims. While we
38 a g r e e w i t h
39 appellants that
40 references may not
41 be combined
42 indiscriminately and

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1 with guidance from
2 appellants'
3 disclosure to show
4 that claims are
5 unpatentable, we
6 think the
7 combination of
8 references her is
9 proper and
10 adequately suggests
11 the structure
12 appellants have
13 achieved." [at 657]
14 [Emphasis added]

15 And, in Panduit Corp. v. Burndy Corporation et al., 180
16 USPQ 498 (District Court, N.D. Illinois, E. Div.), where the
17 Court held:

18 "Inquiry into the
19 patentability must
20 be directed toward
21 subject matter as a
22 whole and not to
23 elements of a
24 combination and
25 their individual
26 novelty; combination
27 which results in a
28 more facile,
29 economical, or
30 efficient unit, or
31 which provides
32 results unachieved
33 by prior art
34 structures, cannot
35 be anticipated
36 piecemeal by showing
37 that elements are
38 individually old."
39 [at 498] [Emphasis
40 added]

41 "The inquiry into
42 the patentability

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1 must be directed
2 toward the subject
3 matter as a whole
4 and not to the
5 elements of the
6 claimed combination
7 and their individual
8 novelty, and
9 therefore a patented
10 combination which
11 results in a more
12 facile, economical
13 or efficient unit,
14 or which provides
15 results unachieved
16 by prior art
17 structures, cannot
18 be anticipated
19 piecemeal by showing
20 that the various
21 elements of the
22 invention are
23 individually old.
24 The difference
25 between the subject
26 matter set forth in
27 the Re. 26,492
28 patent and the
29 subject matter of
30 the cited prior art
31 references as a
32 whole would not have
33 been obvious at the
34 time the invention
35 was made to a person
36 of ordinary skill in
37 the art to which
38 such subject matter
39 pertains, under 35
40 U.S.C. 103.[at 505]
41 [Emphasis added]

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1 And, in Monarch Knitting Mach. Corp. v. Sulzer Morat
 2 GmbH, 139 F.3d 877, 45 USPQ.2d 1977 (Fed. Cir. 1998), where
 3 the Court held:

4 "Federal district
 5 court's formulation
 6 of problem
 7 confronting
 8 inventors of needles
 9 for automatic
 10 knitting machine
 11 presumes their
 12 solution to problem,
 13 namely modification
 14 of "stem segment" of
 15 needles; defining
 16 problem in terms of
 17 its solution reveals
 18 improper hindsight
 19 in selection of
 20 prior art relevant
 21 to obviousness,
 22 resulted in district
 23 court adopting
 24 overly narrow view
 25 of scope of prior
 26 art, and infected
 27 district court's
 28 determinations about
 29 content of prior
 30 art." [at 1978]
 31 [Emphasis added]

32 "To ascertain the
 33 scope of the prior
 34 art, a court
 35 examines "the field
 36 of the inventor's
 37 endeavor,"
 38 Shatterproof Glass
 39 Corp. v. Libbey-
 40 Owens Ford Co., 758
 41 F.2d 613, 620, 225
 42 USPQ 634, 628 (Fed.
 43 Cir. 1985), and

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1 "the particular
2 problem with which
3 the inventor was
4 involved,"
5 Stratoflex, Inc. v.
6 Aerquip Corp., 713
7 F.2d 1530, 1535, 218
8 USPQ 871, 876 (Fed.
9 Cir. 1983) (quoting
10 In re Wood 599 F.2d
11 1032, 1036, 202 USPQ
12 171, 174 (CCPA
13 1979)), at the "time
14 the invention was
15 made," see 35 U.S.C.
16 § 103(a). The
17 district court
18 defined the problem
19 as "designing the
20 stem segment of a
21 knitting
22 needle... [to]
23 minimize[] needle
24 head breakage and
25 thus maximize[] the
26 operating speed of
27 an industrial
28 knitting machine."
29 (emphasis added).
30 The '053 patent, on
31 the other hand,
32 describes the
33 inventor's problem
34 as "providing
35 [knitting needles]
36 with a means which
37 avoids head
38 breakages or lets
39 [breakages] start to
40 an extent worth
41 mentioning only at
42 higher knitting
43 speeds." '053
44 patent, col. 1,
45 lines 48-51. The
46 district court's

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1 formulation of the
2 problem confronting
3 the '053 inventors
4 presumes the
5 solution to the
6 problem -
7 modification of the
8 stem segment.
9 defining the problem
10 in terms of its
11 solution reveals
12 improper hindsight
13 in the selection of
14 the prior art
15 relevant to
16 obviousness. See,
17 e.g. In re Antle,
18 444 F.2d 1168, 1171-
19 72, 170 USPQ 285,
20 287-88 (CCPA 1971)
21 (warning against
22 selection of prior
23 art with hindsight).
24 By importing the
25 ultimate solution
26 into the problem
27 facing the
28 inventors, the
29 district court
30 adopted an overly
31 narrow view of the
32 scope of the prior
33 art. It also
34 infected the
35 district court's
36 determinations about
37 the content of the
38 prior art." [at 1981]
39 [Emphasis added]

40 And, in In re Rouffet, 149 F.3d 1350, 47 USPQ.2d 1453
41 (Fed. Cir. 1998), where the Court reversed the Board's
42 decision in which the level of skill in the art being high was
43 not sufficient to supply motivation:

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1 "Three possible
2 sources for
3 motivation to
4 combine prior art
5 references in manner
6 that would render
7 claimed invention
8 obvious are nature
9 of problem to be
10 solved, teachings of
11 prior art, and
12 knowledge of persons
13 of ordinary skill in
14 art; high level of
15 skill in field of
16 art cannot be relied
17 upon to provide
18 necessary motivation
19 absent explanation
20 of what specific
21 understanding or
22 technical principle.
23 within knowledge one
24 of ordinary skill in
25 art, would have
26 suggested
27 combination, since
28 if such rote
29 invocation could
30 suffice to supply
31 motivation to
32 combine, more
33 sophisticated
34 scientific fields
35 would rarely, if
36 ever, experience
37 patentable technical
38 advance." [at 1453]
39 [Emphasis added]

40 "Claimed low orbit
41 satellite
42 communication system
43 for mobile terminals
44 is not prima facie
45 obvious over

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1 combination of two
2 prior art
3 references, even
4 though person
5 possessing high
6 level of skill
7 characteristic of
8 this field would
9 know to account for
10 differences between
11 claimed invention
12 and prior art
13 combination, since
14 high level of skill
15 in art, without
16 more, cannot supply
17 required motivation
18 to combine
19 references, and does
20 not overcome absence
21 of any actual
22 suggestion to
23 combine; obviousness
24 rejection will not
25 be upheld, even
26 where skill in art
27 is high, absent
28 specific
29 identification of
30 principle, known to
31 one of ordinary
32 skill, that suggests
33 claimed
34 combination." [at
35 1454] [Emphasis
36 added]

37 Let's say hypothetically, however, that there is a
38 motivating suggestion that the edge binding of Ang can be
39 modified to use the welt with an anchoring tape of Higgins et
40 al., as suggested by the Examiner and which applicant does not
41 contend as discussed supra, a holding of obviousness can still
42 not be made out because pursuant to 37 CFR 1.111(c), amended

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1 claim 1 describes the following advantageous distinctive
2 features that distinguish over and avoid the prior art:

3 a) "one strip of said
4 pair of adhesive
5 strips of said
6 adhesive completely
7 covers one surface
8 of said pair of
9 opposing surfaces of
10 said tape" [Emphasis
11 added];

12 b) "the other strip of
13 said pair of
14 adhesive strips of
15 said adhesive is
16 adjacent one edge of
17 said pair of
18 opposing edges of
19 said tape" [Emphasis
20 added];

21 c) "said welting is
22 adhered to said tape
23 . . ." [Emphasis
24 added];

25 d) "said tape adheres
26 to said welting"
27 [Emphasis added];
28 and

29 e) "said terminating
30 portion of said tape
31 overlies said
32 originating portion
33 of said tape and is
34 adhered thereto . . ."
35 [Emphasis added].

36 It was decided in In re Miller, 169 USPQ 597 (CCPA 1971)
37 that each and every limitation of amended claim 1 discussed
38 supra must be met in determining patentability:

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1 "All words in a
 2 claim must be
 3 considered in
 4 judging the
 5 patentability of
 6 that claim against
 7 the prior art." [at
 8 600] [Emphasis added]

9 In this same regard, the Examiner's attention is
 10 respectfully directed to the decisions in In re Fuetterer, 138
 11 USPQ 217 (CCPA 1963); and In re Ludke and Sloan, 169 USPQ 563
 12 (CCPA 1971).

13 When the thermoglue binding tape of amended claim 1 is
 14 designed in accordance with the advantageous distinctive
 15 features of amended claim 1 discussed supra, inter alia:

16 1. The welting is adhered completely to the tape ipso facto
 17 "one strip of said pair of adhesive strips of said
 18 adhesive completely covers one surface of said pair of
 19 opposing surfaces of said tape" [Emphasis added].

20 2. A flange is formed by the tape for the underside of the
 21 carpet edge to adhere onto thereby affixing the welting
 22 to the carpet edge without impinging upon the upperside
 23 of the carpet edge and aesthetically distracting
 24 therefrom ipso facto "the other strip of said pair of
 25 adhesive strips of said adhesive is adjacent one edge of
 26 said pair of opposing edges of said tape" [Emphasis added]
 27 and "said terminating portion of said tape overlies said
 28 originating portion of said tape and is adhered thereto
 29 ... [Emphasis added"].

30 3. The welting is prevented from moving relative to the tape
 31 ipso facto "said welting is adhered to said

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1 tape..."Emphasis added] and "said tape adheres to said
2 welting"[Emphasis added].

3 Even though the advantageous features of amended claim
4 1 discussed supra may not have been disclosed and discussed
5 specifically in the specification of the patent application
6 as it was originally filed, they still must be relied upon as
7 evidence of patentability, as was decided in In re Chu, 66
8 F.3d 292, 36 USPQ.2d 1089 (Fed. Cir. 1995), where the Court
9 held:

10 "Board of Patent
11 Appeals and
12 Interferences erred,
13 in upholding
14 obviousness
15 rejection of
16 applicant's claims,
17 by concluding that
18 claims' disclosure
19 was matter of
20 "design choice," and
21 that the applicant's
22 evidence and
23 arguments to
24 contrary are not
25 present in
26 specification and
27 are therefore
28 unpersuasive, since
29 board is required to
30 consider totality of
31 record and is not
32 free to disregard
33 evidence and
34 arguments presented
35 by applicants, and
36 since there is no
37 support for
38 proposition that
39 evidence and/or
40 arguments traversing

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1 ...rejection must be
2 contained within
3 specification, given
4 that [patentability]
5 is determined by
6 totality of record
7 including, in some
8 instances most
9 significantly,
10 evidence and
11 arguments proffered
12 during give-and-take
13 of ex parte patent
14 prosecution." [at
15 1090] [Emphasis
16 added]

17 "Because the Board
18 was required to
19 consider the
20 totality of the
21 record, the Board
22 was not free to
23 disregard the
24 evidence and
25 arguments presented
26 by Chu in response
27 to the obviousness
28 r e j e c t i o n .
29 Additionally, the
30 Board erred in
31 apparently requiring
32 Chu's evidence and
33 arguments responsive
34 to the...rejection
35 to be within his
36 specification in
37 order to be
38 considered. To
39 require Chu to
40 include evidence and
41 arguments in the
42 s p e c i f i c a t i o n
43 regarding whether
44 placement of the SCR
45 catalyst in the bag

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1 retainer was a
2 matter of "design
3 choice" would be to
4 require patent
5 applicants to divine
6 the rejections the
7 PTO will proffer
8 when patent
9 applications are
10 filed." [at 1094]
11 [Emphasis added]

12 "We have found no
13 cases supporting the
14 position that a
15 patent applicant's
16 evidence and/or
17 arguments traversing
18 a...rejection must
19 be contained within
20 the specification.
21 There is no logical
22 support for such a
23 proposition as well,
24 given that
25 [patentability] is
26 determined by the
27 totality of the
28 record including, in
29 some instances, most
30 significantly, the
31 evidence and
32 arguments proffered
33 during the give-and-
34 take of ex parte
35 p a t e n t
36 prosecution." [at
37 1095] [Emphasis
38 added]

39 And, even though the advantageous distinctive features
40 of amended claim 1 may be considered simple and accomplish
41 only a small but genuine improvement by some is not sufficient
42 reason to deny it patent protection, as was decided in Schnell

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1 et al. v. The Allbright-Nell Company et al., 146 USPQ 322
 2 (Court of Appeals, Seventh Circuit 1965), where the Court
 3 held:

4 "Device _____ seems
 5 simple...in light of
 6 patentee's teaching,
 7 but it evidently was
 8 not...at time of
 9 invention; those
 10 working in the field
 11 did not accomplish
 12 patentee's results;
 13 that fact supports
 14 conclusion that
 15 patentee achieved
 16 p a t e n t a b l e
 17 invention."[at 322]
 18 [Emphasis added]

19 "This now seems
 20 simple...in the
 21 light of the Schnell
 22 teaching, but is was
 23 evidently not at all
 24 ...at the time of
 25 the invention.
 26 Those working in the
 27 field did not
 28 accomplish Schnell's
 29 results. That fact
 30 supports the
 31 conclusion that
 32 Schnell achieved
 33 p a t e n t a b l e
 34 inventions. Pyle
 35 Nat. Co. v. Lewin, 7
 36 Cir., 1937, 92 F.2d
 37 628, 630, 35 USPQ
 38 40, 42."[at 324]
 39 [Emphasis added]

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1 The Board of Appeals expressed the same concept when it
2 held in Ex parte Grasenick and Gessner, 158 USPQ 624 (Patent
3 Office Board of Appeals 1967), that:

4 "Improvement over
5 prior art, even
6 though it be
7 simple...is
8 patentable...." [at
9 624] [Emphasis added]

10 "This rejection is
11 in error. An
12 improvement over the
13 prior art, even
14 though it be
15 simple...is
16 patentable....The
17 examiner has neither
18 cited evidence
19 establishing the
20 [unpatentability] of
21 a p p e l l a n t ' s
22 modification of the
23 prior art nor
24 demonstrated that
25 the improved results
26 c l a i m e d by
27 appellants are not
28 available from their
29 construction." [at
30 624] [Emphasis added]

31 Attention is also respectfully directed in this regard
32 to the decisions in Mercantile National Bank of Chicago et al
33 v. Ovest, Inc. et al. DC., N.D. Indiana, 166 USPQ 517; In re
34 Shelby, 136 USPQ 220; and In re Irani and Moedritzer, 166 USPQ
35 24, which all indicate that simplicity does not operate as a
36 bar to patentability.

37 Turning now to the references, and particularly to
38 Higgins et al., in contradistinction, Higgins et al. do not

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1 teach "one strip of said pair of adhesive strips of said
2 adhesive completely covers one surface of said pair of
3 opposing surfaces of said tape" [Emphasis added] and "the other
4 strip of adhesive of the pair of adhesives strips of said
5 adhesive is adjacent one edge of said pair of opposing edges
6 of said tape" [Emphasis added] as required by advantageous
7 distinctive features a) and b) of amended claim 1 discussed
8 supra, but rather Higgins teaches no adhesive on either of its
9 legs 20 and 21, but rather sewing, with the adhesive being on
10 one leg of the anchor tape 10 which is separate from the
11 welting 19 and does not form a part thereof as shown in FIGURE
12 2 of Higgins et al. [relied upon by the Examiner] and as
13 discussed at, for example, col. 3, lines 2-6 of Higgins et
14 al., where it is disclosed:

15 "In the illustrated
16 m a t t r e s s
17 construction, the
18 second anchor
19 portion 13 is
20 attached to the
21 mattress cover by
22 sewing to the second
23 leg 21 of the
24 welting 19 along
25 with the top portion
26 22 of the mattress
27 cover." [Emphasis
28 added]

29 With this arrangement of Higgins et al., the welting is
30 not adhered completely to the tape.

31 With further reference to Higgins et al., in further
32 contradistinction, Higgins et al. are silent as to how the
33 welting and the tape are affixed to each other. Absent such

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1 a disclosure, one cannot say that Higgins et al. teach
2 advantageous distinctive features c) and d) of amended claim
3 1 discussed supra.

4 With further reference to Higgins et al., and in further
5 contradistinction, Higgins et al. do not teach "said
6 terminating portion of said tape overlies said originating
7 portion of said tape and is adhered thereto..." [Emphasis
8 added] as required by advantageous distinctive feature e) of
9 amended claim 1 discussed supra, but rather Higgins et al.
10 teach that the first leg 20 [relied upon by the Examiner as
11 the originating portion of the tape of amended claim 1] does
12 not overlie the second leg 21 [relied upon as the terminating
13 portion of amended claim 1] but rather is perpendicular
14 thereto as shown in FIGURE 2 of Higgins et al. [relied upon
15 by the Examiner] and as discussed at col. 2, lines 50-53 of
16 Higgins et al., where it is disclosed:

17 "The welting 19 has
18 a first leg 20 and a
19 second leg 21 to
20 which top and side
21 portions 23 and 22
22 may be sewn or
23 otherwise suitably
24 attached." [Emphasis
25 added]

26 With this arrangement of Higgins et al., a flange is not
27 formed by the tape for the underside of the carpet edge to
28 adhere onto thereby not affixing the welting to the carpet
29 edge without impinging upon the upperside of the carpet edge
30 and aesthetically distracting therefrom

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1 Applicant has provided clear and convincing evidence that
2 the prior art does not accomplish applicant's result of
3 providing an efficient thermoglue binding tape that, inter
4 alia:

5 1. Adheres the welting completely to the tape.
6 2. Forms a flange by the tape for the underside of the
7 carpet edge to adhere onto thereby affixing the welting
8 to the carpet edge without impinging upon the upperside
9 of the carpet edge and aesthetically distracting
10 therefrom.

11 3. Prevents the welting from moving relative to the tape.
12 Therefore a holding of obviousness cannot be made out,
13 as was decided by the Board of Appeals in Ex parte Tanaka,
14 Marushima and Takahashi, 174 USPQ 38, where the Board held:

15 "Claims are not
16 rejected on the
17 ground that it would
18 be obvious to one of
19 ordinary skill in
20 the art if the prior
21 art devices do not
22 accomplish
23 applicant's result."
24 [Emphasis added]

25 And, in In re Wright, 122 USPQ 522 (1959), where the
26 Court held:

27 "...the mere
28 aggregation of old
29 elements that did
30 not perform a
31 different function
32 is not a patentable
33 invention, but that
34 a novel combination
35 of old elements

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1 which cooperate with
2 each other to
3 produce a new or
4 useful result or a
5 substantial increase
6 in efficiency is
7 patentable. "
8 [Emphasis added]

9 And, further in the en banc decision in In re Dillon, 919
10 F.2d 688, 692 (Fed. Cir. 1990), where the Court held:

11 "...a prima facie
12 case of obviousness
13 requires that the
14 prior art suggest
15 the claimed
16 compositions'
17 properties and the
18 problem the
19 applicant attempts
20 to solve." [Emphasis
21 added]

22 In this same regard, the Examiner's attention is
23 respectfully directed to the decisions in In re Halleck, 164
24 USPQ 647 (CCPA 1970); and Kockum Industries, Inc. v. Salem
25 Equipment, Inc., 175 USPQ 81 (9th Cir. 1972).

26 In view of, inter alia, In re Deuel, Richardson-Vicks
27 Inc. v. The Upjohn Co., the Graham v. John Deere Co. test in
28 light of, inter alia, MPEP 706.02, In re Jones, Arkie Lures,
29 Inc. v. Gene Larew Tackle, Inc., Gambro Lundia AB v. Baxter
30 Healthcare Corporation, In re Fritch, Heidelberger
31 Druckmaschinen AG v. Hantscho Commercial Products, Inc., In
32 re Fine, In re Keller, and In re Merck & Co., Inc., In re Kamm
33 and Young, In re Stephens, Wenzl, and Browne, Panduit Corp.
34 v. Burndy Corporation et al., Monarch Knitting Mach. Corp. v.
35 Sulzer Morat GmbH, In re Rouffet, In re Miller, In re

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1 Fuetterer, In re Ludke and Sloan, In re Chu, Schnell et al.
2 v. The Allbright-Nell Company et al., Ex parte Grasenick and
3 Gessner, Mercantile National Bank of Chicago et al v. Owest,
4 Inc. et al., In re Shelby, In re Irani and Moedritzer, Ex
5 parte Tanaka, Marushima and Takahashi, In re Wright, In re
6 Dillon, In re Halleck, and Kockum Industries, Inc. v. Salem
7 Equipment, Inc., applicant attacks the Examiner's prima facie
8 determination as improperly made out and tending to support
9 a conclusion of nonobviousness as is permitted by the Fritch
10 Court, at 1783, where the court further held:

11 "In proceedings
12 before the Patent
13 and Trademark
14 Office, the Examiner
15 bears the burden of
16 establishing a prima
17 facie case of
18 obviousness based
19 upon the prior art
20[The Examiner]
21 can satisfy this
22 burden only by
23 showing some
24 objective teaching
25 in the prior art or
26 that knowledge
27 generally available
28 to one of ordinary
29 skill in the art
30 would lead to that
31 individual to
32 combine the relevant
33 teachings of the
34 references. The
35 patent applicant may
36 then attack the
37 Examiner's prima
38 facie determination
39 as improperly made
40 out, or the


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1 applicant may
2 present objective
3 evidence tending to
4 support a conclusion
5 of nonobviousness."
6 [Emphasis added]

7 In view of the cancellation of claims 2-11 and 13-16
8 without prejudice or disclaimer, the amendment made supra to
9 claim 1 to include the limitations of cancelled claims 5, 10,
10 11, and 13-16, the amendments made supra to claims 12 and 17
11 to reflect proper dependency, and the arguments presented
12 supra, applicant respectfully submits that the Examiner's
13 grounds for the rejection of claims 1-10 under 35 U.S.C.
14 102(e) as being anticipated by Ang, the Examiner's grounds for
15 the rejection of claims 1-4 under 35 U.S.C. 102(b) as being
16 anticipated by Hamrah, and the Examiner's grounds for the
17 rejection of claims 1-18 under 35 U.S.C. 103(a) as being
18 unpatentable over Ang in view of Higgins et al., are no longer
19 applicable and applicant therefore respectfully requests that
20 the Examiner withdraw these rejections.

21 Respectfully submitted,

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25

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